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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,603	01/18/2002	Daniel John Keeble	30010008 US-02	2972

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EXAMINER

MACCHIAROLO, PETER J

ART UNIT PAPER NUMBER

2875

DATE MAILED: 11/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/052,603	Applicant(s) KEEBLE ET AL.	
	Examiner Peter J Macchiarolo	Art Unit 2875	
	-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --		

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on ____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-13 is/are pending in the application.

4a) Of the above claim(s) ____ is/are withdrawn from consideration.

5) ☐ Claim(s) ____ is/are allowed.

6) ☒ Claim(s) 1-13 is/are rejected.

7) ☐ Claim(s) ____ is/are objected to.

8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some * c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. ____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) . .

4) ☐ Interview Summary (PTO-413) Paper No(s). ____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____

DETAILED ACTION

Priority

1. Receipt of the claim for foreign priority is acknowledged.

Response to Amendment

2. The Examiner notes that Preliminary amendment, filed January 18, 2002 has been entered and considered.

Information Disclosure Statement

3. The information disclosure statements (IDS) submitted on January 18, 2002 and August 20, 2002 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner. The Examiner notes that the application number on the IDS filed on August 20 has been corrected appropriately.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the transmitter and receiver as recited in claims 1, 6, and 13 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 118

6. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

7. Claims 6, 8, and 13 are objected to because of the following informalities:

8. Claims 6 and 13 recite the term, "said module electrical connector means" in the last line of the claims. However, there is not proper antecedent basis for this term. Appropriate correction is required.

9. Claim 8 recites the term, "said system electrical connectors," however there is not proper antecedent basis for this term. The Examiner is interpreting this as the electrical connection of the module. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kayner (USPN 5,767,999; "Kayner") in view of Poplawski et al (USPN 5,734,558; "Poplawski").

11. In regards to claims 1, 6, and 13, Kayner discloses in figures 1a-2, an optical transceiver system having an optical transceiver module (10) including a housing (20, 22) having disposed

therein a transmitter (16) and receiver (18), and a plurality of spring-like fingers (40) to enable the module to be removably inserted into a suitably configured board (124), and the system further comprises a chassis (12) having the board disposed therein, and chassis electrical connector means (6) is arranged to receive a module electrical connector means (26).

12. Kayner shows that the rails (94) are on opposite sides of the chassis, not on opposite sides of the housing.

13. However, Poplawski teaches that having the rails (350) integrated with a plurality of spring-like fingers (360) and attached to the housing (312) to enable said module to be removably inserted into a suitably configured board (128) allows for a robust optoelectronic transceiver module which is quick, easy, and inexpensive to manufacture¹.

14. Therefore, one would be motivated to place Kayner's rails on opposite sides of the module with integrated spring like fingers, and the corresponding grooves on the chassis, since this configuration would still allow for proper alignment and retention, without destroying the device, while allowing for a robust optoelectronic transceiver module which is quick, easy, and inexpensive to manufacture. Further, rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

15. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct Kayner's system, including the rails on opposite sides of the module with integrated spring like fingers, since Poplawski teaches this allows for a robust optoelectronic transceiver module which is quick, easy, and inexpensive to manufacture.

¹ Poplawski, abstract.

16. The Examiner further notes that the preamble of claim 13 recites that the optical transceiver system is part of an optical telecommunications network. This is an intended use type preamble, and is not afforded any patentable weight, since it merely recites the intended use of an optical transceiver system. Where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone, the preamble is generally not accorded any patentable weight. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

17. In regards to claims 2-5, and 7-12, Kayner teaches all of the recited limitations of claims 1 and 6 (above).

18. Kayner further shows that the electrical connection means are disposed at a back end of the module, and the housing includes a plurality of fins (30, 32) disposed thereon. Kayner further shows the housing comprises an upper half (20) and a lower half (22) sandwiched together, and an electrically conductive gasket (50) disposed there between. Kayner further shows the front end of the module has a bezel (21), and the bezel has a pair of arms each extending from diagonally opposite corners of the bezel. Kayner further teaches the suitably configured board is disposed within the chassis on a plurality of mounting means (108), and further that a shield means (36, 38, 39) is disposed substantially around the module and the system electrical connectors and has a plurality of resilient fingers (44) arranged to exert pressure

on the housing. Kayner further teaches that the module, chassis and board are electrically grounded².

19. Kayner is silent to a layer of electrically conductive material being disposed on the suitably configured board in an area substantially surrounding the module.

20. However, one of ordinary skill in the art will appreciate that efficient and accurate operation of the optical transceiver can be realized only if a reliable, solid electrical ground is made to the system's components. Coating a layer of gold on the board is one known configuration that will ensure the system's components are properly and certainly grounded, therefore, making this an obvious matter of design choice.

21. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct Kayner's system, including layering gold on the suitably configured board in an area substantially surrounding the module, since this configuration will ensure the system's components are properly and certainly grounded, thereby realizing efficient and accurate operation of the transceiver.

22. The Examiner further notes that the limitations in claim 2, "to facilitate temperature control of said module," claim 5, "to facilitate electrical connection between said upper and lower halves," claim 7, "so as to enable air to pass both above and below said module," claim 8, "so as to provide electrical connection from said module to said suitably configured board," and claim 9, "so as to improve electrical connection between said housing and said shield means," are intended use type limitations. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to

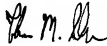
² Kayner, abstract.

patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
24. U.S. Patents 5,879,173 to Poplawski et al; 6,215,666 to Hileman et al; 6,483,711 to Huang; 6,502,998 to Yen et al; and 6,607,308 to Dair et al all disclose pluggable transceiver modules which are similar to Applicant's. They disclose and teach several limitations of Applicant, such as why it is important to have a properly grounded system, why pillars are needed to separate the board and chassis to name a few. However, they are not relied upon in this Office Action.
25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J Macchiarolo whose telephone number is (703) 305-7198. The examiner can normally be reached on 7:30 - 4:30, M-F.
26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (703) 305-4939. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.
27. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

pjm


THOMAS M. SEMBER
PRIMARY EXAMINER